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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,003	09/27/2001	Rabindranath Dutta	AUS920010684US1	2730
48916	7590	05/13/2008		EXAMINER
Greg Goshorn, P.C. 9600 Escarpment Suite 745-9 AUSTIN, TX 78749				KOHUT, DAVID M
			ART UNIT	PAPER NUMBER
			3626	
				MAIL DATE
				DELIVERY MODE
			05/13/2008	PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/965,003

Filing Date: September 27, 2001

Appellant(s): DUTTA ET AL.

Gregory K. Goshorn
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10 March 2008 appealing from the Office action mailed 10 August 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,845,255	Mayaud	12-1998
2002/0026332	Snowden et al.	02-2002

6,283,761

Joao

09-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections – 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6 and 8-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayaud (5,845,255; hereinafter Mayaud), in view of Joao (6,283,761; hereinafter Joao), and in view of Snowden et al. (US 2002/0026332; hereinafter Snowden).

- (A) As per claim 1, Mayaud discloses a method comprising:

- (a) receiving a patient prescription for a specified medication (Mayaud: col. 27, lines 30-39);
- (b) verifying availability of insurance coverage from an insurance company for the patient prescription (Mayaud: col. 15, lines 48-53; col. 21, lines 33-41; col. 53, lines 23-34); and
- (c) verifying an insurance payment category for the prescription (Mayaud: col. 5, lines 33-43).

Mayaud, however, fails to expressly disclose a method comprising:

- (d) collecting the payment from the patient based on the payment category;

- (e) transmitting the payment category and the payment to the insurance company; and
- (f) excluding the medication information.

Nevertheless, these features are old and well known, as evidenced by Joao and Snowden. In particular, Joao and Snowden disclose a method comprising:

- (d) collecting the payment from the patient based on the payment category (Joao: col. 37, lines 47-65);
- (e) transmitting the payment category and the payment to the insurance company (Joao: col. 37 lines 47-65; Fig. 1);
- (f) excluding the medication information (Snowden: ¶ [0065], [0079], [0085]).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the combined teachings of Mayaud and Snowden with the motivation of providing a means for securing the confidentiality of patient information, in whole or in part,, while making medical payments (Joao: col. 7, lines 16-24).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Snowden with the combined teachings of Mayaud and Joao with the motivation of providing a means for securing the confidentiality of patient information, in whole or in part, while making medical payments (Snowden: ¶ [0121].

(B) As per claim 2, Mayaud discloses the method of claim 1 wherein the payment category is a brand name (Mayaud: col. 4, lines 60-65).

Examiner has noted insofar as claim 2 recites, "selected from brand name,

generic, and not covered," brand name has been recited.

- (C) As per claim 3, Mayaud discloses the method of claim 1 further comprising dispensing the prescription to the patient (Mayaud: abstract; col. 4, lines 29-35).
- (D) As per claim 4, Mayaud discloses the method of claim 1 further comprising collecting patient preexisting prescription information and patient insurance information from a storage medium (Mayaud: col. 15, lines 47-58; col. 21, lines 33-41; col. 41, lines 42-67; col. 42, lines 1-16; Fig. 12).
- (E) As per claim 5, Mayaud fails to expressly disclose the method of claim 4 further comprising recording the prescription and the payment on the storage medium.

Nevertheless, these features are old and well known, as evidenced by Joao. In particular, Joao discloses the method of claim 4 further comprising recording the prescription and the payment on the storage medium (Joao: col. 16, lines 33-65; col. 17, lines 25-67; col. 18, lines 1-33; col. 19, lines 7-67; col. 20, lines 1-8; col. 37, lines 47-65; Fig. 1).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the teachings of Mayaud with the motivation of providing an apparatus and method for processing and/or providing healthcare information and/or healthcare-related information for facilitating a variety of healthcare applications (Joao: col. 8, lines 3-14).

- (F) As per claim 6, Mayaud discloses the method of claim 1 further comprising checking for adverse reactions between the patient prescription and at least one preexisting patient prescription (Mayaud: col. 31, lines 18-67; col. 32, lines i-21).

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(G) Claim 8 differs from method claim 1 by reciting "a computer product in a computer readable medium" within its preamble. As per these elements, Mayaud's patient information management system includes computers, databases, interfaces, and gateway-routers, among other components (Mayaud: col. 45, lines 7-67; col. 46, lines 1-67; col. 47, lines 1-10; Fig. 16). As such, it is readily apparent that Mayaud's patient information management system is controlled by a computer product in a computer readable medium."

The remainder of claim 8 substantially repeats the same limitations of method claim 1 and is therefore, rejected for the same reasons given above for claim 1, and incorporated herein.

(H) Claims 9-13 substantially repeat the same limitation's of claims 2-6 and are therefore, rejected for the same reasons given for those claims.

(I) Claim 14 differs from method claim 1 by reciting hardware elements, namely, a receiving means, a first verifying means, a second verifying means, a collecting means, and a transmitting means. As per these elements, it is submitted that because the teachings of Mayaud and Joao disclose the process steps recited in method claim 1, claim 1, in order to perform the process steps, discloses the aforementioned hardware elements as well. As such, claim 14 substantially repeats the same limitations of method claim 1 and is therefore, rejected for the same reasons given above for claim 1 and incorporated herein.

(J) Claims 15-19 substantially repeat the same limitations of claims 2-6 and are therefore, rejected for the same reasons given for those claims.

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4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mayaud, as applied to claims 1 above, and further in view of Snowden.

(A) As per claim 7, Mayaud discloses a method comprising:

(a) storing patient prescription information on a storage medium (Mayaud: col. 41, lines 42-67; col. 42, lines 1-16; Fig. 16); and

(b) providing unlimited access to the prescription information to the patient (Mayaud: col. 7, lines 30-45; col. 8, lines 60-63).

Mayaud, however, fails to expressly disclose a method comprising:

(c) providing limited access to the prescription information to third parties in response to authorization by the patient.

Nevertheless, this feature is old and well known in the art, as evidenced by Snowden. In particular, Snowden discloses a method comprising:

(c) providing limited access to the prescription information to third parties in response to authorization by the patient (Snowden: abstract; ¶ [0079]).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Snowden with the teachings of Mayaud with the motivation of providing a means for securing the confidentiality of patient information (Snowden: ¶ [0121]).

(10) Response to Argument

In the Appeal Brief filed 10 March 2008, Appellant makes the following arguments:

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(A) Mayaud, Joao and Snowden do not teach or suggest excluding medication information.

(B) Mayaud, Joao and Snowden do not teach or suggest either "collection based upon a payment category" or "transmission of a payment category".

Examiner will address Appellant's arguments in sequence as they appear in the brief.

Response to Argument (A)

In response to Appellant's argument (A), the Examiner respectfully submits that the combined teachings of Mayaud, Joao and Snowden, *in toto*, do indeed strongly suggest and teach the withholding of medication information in conjunction with the transmission of a request for payment.

First, Snowden teaches that medical information may be made electronically accessible in whole or *select parts* [emphasis added] to appropriate entities (e.g., insurers) (Snowden: ¶ [0079]). In other words, certain entities (e.g., insurers) can be denied access to certain medical information (wherein medical information would include medication information, prescriptions, etc.). In fact, Snowden defines medical records (i.e. medical information) as "...prescribed and over-the-counter medications..." (Snowden: ¶ [0047]).

Second, Mayaud teaches that access to certain medical information can be restricted to a need-to-know basis (Mayaud: col. 10, lines 20-27). Mayaud also teaches that medical information can be transmitted between various entities including insurance companies and pharmacies (Mayaud: col. 16, lines Fig. 16). In other words, certain

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medical information (e.g., medication information) can be withheld or provided to various entities (e.g., insurers) as appropriate.

Third, Joao teaches a comprehensive medical communication network system whereby various entities can communicate any selected information with one another in a bi-directional manner (Joao: col. 37, lines 47-65; Fig. 1). Joao also teaches that various entities may perform financial transactions, such as payments, with one another (Joao: col. 37, lines 47-65). In other words, a payment from any entity (e.g., provider, patient, etc.) along with any medical information can be transmitted to the insurance company.

It would have been obvious to one of ordinary skill in the art to include in the healthcare record system and method of Snowden the ability to transmit or withhold particular medical information between various entities as taught by Mayaud and the ability to communicate in a bi-directional manner and perform financial transactions as taught by Joao since the claimed invention is merely a combination of old elements. In the combination, each element merely would have performed the same function as it did separately. Therefore, one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Argument (B)

In response to Appellant's argument (B), the Examiner respectfully submits that the combined teachings of Mayaud, Joao and Snowden, *in toto*, do indeed strongly suggest and teach "collection based upon a payment category" and/or "transmission of

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a payment category". Appellant particularly argues that Joao does not suggest or teach the above referenced claim limitations.

The Examiner respectfully submits that Joao does suggest and teach the above referenced limitations. Appellant agrees that Joao does suggest and teach payment for services rendered as a basis for either collection or transmission (Appellant's Brief: page 14, lines 10-12). In addition to services rendered, Joao references other types of categories in which the apparatus and method operates. Particularly, Joao references "...provider's service, consultation, treatment, procedure, and/or any other event which triggers coverage under a healthcare insurance policy and/or a payer's liability to pay for services and/or treatments" (Joao: column 37, lines 26-30). While Joao does not explicitly call these "payment categories", it is obvious that these terms are indeed payment categories. Thus, the combination of Mayaud, Joao and Snowden teach the limitations of Appellant's claimed invention.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/David M. Kohut/
Patent Examiner, Art Unit 3626

David M. Kohut
Patent Examiner
Tech Center 3600

Conferees:

/Robert Morgan/
Primary Examiner, Art Unit 3626
Robert Morgan
Primary Patent Examiner
Tech Center 3600

Vincent Millin /VM/

Appeals Practice Specialist